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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,150	12/15/2003	Osamu Nagai	13712	3663

7590 11/01/2004
ORUM & ROTH
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CHICAGO, IL 60604

EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,150	Applicant(s) NAGAI, OSAMU	
	Examiner Melody M. Burch	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 10 mentioned on pg. 6 of the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Objections

3. Claims 1-12 are objected to because of the following informalities:

In line 24 of claim 1 the phrase "in one oil passage" should be changed to --in one of the oil passages--. Similarly, in line 26 of claim 1 the phrase "in the other oil passage" should be changed to --in the other of the oil passages-- in order to properly refer back to the previously recited oil passages. A similar problem exists in claim 2. Appropriate correction is required. The remaining claims are objected to due to their dependency from one of claims 1 and 2.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claim 1. The phrase "one hydraulic shock absorber" in lines 5-6 and "another hydraulic shock absorber" in line 8 lead to confusion. It is unclear to the Examiner whether the absorbers in lines 5-6 and 8 are intended to be the same or different from the hydraulic shock absorbers at right and left sides of a wheel recited earlier in claim 1.

Re: claims 1 and 2. The phrase "mountable to a leading end portion thereof" first claimed in lines 15-16 of claim 1 is indefinite. It is unclear to the Examiner as to which element "thereof" represents. Also, the phrase "a volume compensating oil passage of the piston rod" in line 3 from the bottom of claim 1 is indefinite. It is unclear as to which oil passage Applicant intends to refer to since a volume compensating oil passage 50 is

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shown in the drawings, however, passage 50 is a part of the damper cylinder and not the piston rod as claimed. Clarification is required.

Re: claims 2, 4, 6, 8, 10, and 12. The phrase "the piston" in line 5 from the bottom of claim 2 is indefinite. It is unclear to the Examiner whether Applicant intends to refer to the piston of the "one of the hydraulic shock absorbers" or the "another of the hydraulic shock absorbers". This problem also holds true for the phrase "the oil reservoir chamber" and "the piston side oil chamber", for example in the last two lines of claim 2. The examples are not intended to be exhaustive. Examiner recommends using such language as --first (or left) hydraulic shock absorber--, --first (or left) oil reservoir chamber-- to clearly differentiate the components of the different absorbers. Similar problems exist in claims 4, 6, 8, 10, and 12.

Re: claims 9-12. The phrase "the oil passage" in line 2 of the claims is indefinite. It is unclear to the Examiner which oil passage Applicant intends to refer to: one of the two oil passages or the oil passage of the piston rod communicating the piston rod side oil chamber with the oil reservoir chamber. The remaining claims are indefinite due to their dependency from one of claims 1 and 2.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5797594 to Sekine et al. in view of JP-6441495 (JP'495).

Re: claims 1 and 2. Sekine et al. show in figure 1 a hydraulic shock absorbing apparatus of a vehicle comprising: a compression side damping force generating structure for mainly generating a compression side damping force is provided in one hydraulic shock absorber, the one hydraulic shock absorber having a vehicle body side tube 2 and a wheel side tube shown surrounding tube 2 near the bottom of tube 2 which are slidably fitted to each other; a damper having a damper cylinder 8,11 and a piston rod 18 in which a piston slidable within the damper cylinder is mountable to a leading end portion thereof, and structured such that the damper cylinder is mountable to an inner side of the wheel side tube via intermediate element 3 and the piston rod is mountable to an inner side of the vehicle body side tube via intervening element 9; a piston rod side oil chamber 8a and a piston side oil chamber 8b sectioned within the damper cylinder by the piston, an oil reservoir chamber 10 disposed in an outer periphery of the damper cylinder; and two oil passages 20,21 provided in the piston, a compression side damping valve 23 being provided in one oil passage, and a check valve 22 closing during compression and opening during expansion being provided in the other oil passage, and wherein a volume compensating oil passage 12 of the piston rod communicating the piston rod side oil chamber with the oil reservoir chamber is provided by way of elements 44 and 8b.

Sekine et al. describe the invention substantially as set forth above, but is silent as to having one of the shock absorbers at right and left sides of a wheel with an

expansion side damping force generating structure for mainly generating an expansion side damping force is provided in another hydraulic shock absorber.

JP'495 teaches in pgs 1-2 of the description of the related art section of the instant specification the use of having shock absorbers at both sides of a wheel with one absorber providing the expansion side damping force generating apparatus and the other of the other of the absorbers providing the compression side damping force generating apparatus.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shock absorber arrangement of Sekine et al. to have included one of the shock absorbers on both sides of a wheel, as taught by JP'495, in order to provide a means of effectively damping both expansion and compression strokes for a wheel to improve the feel of the ride.

Re: claims 3 and 4. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein a bypass oil passage 44 communicating the oil chambers in both sides of the piston is disposed in the piston rod of each of the hydraulic shock absorbers, and a damping force adjusting valve 28a is disposed in the bypass oil passage.

Re: claims 5-8. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein the oil passage 12 of the one hydraulic shock absorber is disposed in a (bottom) side wall of the damper cylinder.

Re: claims 9-12. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein the oil passage 44 of the one hydraulic shock absorber is disposed in a guide member 16 for guiding the piston rod 18.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents: 6234505 to Ito, 5934697 to McAndrews, 4964625 to Kawamura, 6659242 to Nagai, 5467852 to de Kock, and US Patent applications 2002/0175035 to Achenbach and 2003/0213664 to Beck teach similar inventions including an outer tube, a damping cylinder, with a reservoir between the tube and the cylinder, and a hollow piston rod with a piston.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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October 27, 2004

Melody M. Burch

10/27/04